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PATENT APPLICATION

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IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): Lambert, et al.

Confirmation No.: 4732

Application No.: 10/808,358

Examiner: Pape, Zachary

Filing Date: March 25, 2004

Group Art Unit: 2835

Title: Reconfigurable Electronic Device Chassis And Interchangeable Access Panels For Use In Same

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TRANSMITTAL OF REPLY BRIEF

Transmitted herewith is the Reply Brief with respect to the Examiner's Answer mailed on November 14, 2006.

This Reply Brief is being filed pursuant to 37 CFR 1.193(b) within two months of the date of the Examiner's Answer.

(Note: Extensions of time are not allowed under 37 CFR 1.136(a))

(Note: Failure to file a Reply Brief will result in dismissal of the Appeal as to the claims made subject to an expressly stated new ground rejection.)

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Respectfully submitted,

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PATENT

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In the Matter of the
Application of: Lambert, et al.
Serial No.: 10/808,358
Filed: March 25, 2004
Entitled: RECONFIGURABLE ELECTRONIC DEVICE
CHASSIS AND INTERCHANGEABLE
ACCESS PANELS FOR USE IN SAME
Docket No.: 200312909-1

Group Art Unit: 2835
Examiner: Pape Zachary

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**REPLY BRIEF
UNDER 37 C.F.R. § 41.41**

1. In response to the Examiner's Answer mailed on November 14, 2006, Appellants submit the following reply brief under 37 C.F.R. § 41.41.

I. ARGUMENT

2. There are three issues discussed on pages 6-10 of the Examiner's Answer that necessitate an additional response by Appellants regarding the rejections of claims 1-7 and 9-15 under 35 USC §103(a) as unpatentable over U.S. Patent No. 5,564,930 to Yu (Yu '930) in view of U.S. Patent No. 6,059,386 to Yu (Yu '386). These issues relate to: (1) the fact that the Examiner's Answer has still failed to properly make a *prima facie* case of obviousness; (2) the fact that, contrary to the allegations in the Examiner's Answer, the Final Office Action has not identified any substantial evidence to support the Examiner's proposed motivation to combine Yu '930 with Yu '386; and (3) the fact that, contrary to the allegations set out in the Examiner's Answer, the Examiner's proposed combination is based on hindsight. The arguments presented below are a further clarification to the arguments set forth in Appellants'

Appeal Brief. In fact, Appellants believe that the Examiner has failed to rebut a single argument set forth in Appellants' Appeal Brief filed on September 15, 2006.

A. The Examiner improperly rejected independent claims 1 and 6, and dependent claims 2-5, 7, and 9-15 as being unpatentable over Yu '930 in view of Yu '386 because there is no suggestion or motivation in the applied art to combine the teachings of Yu '930 and Yu '386.

3. Independent claims 1 and 6 and dependent claims 2-5, 7 and 9-15 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Yu '930 in view of Yu '386. Appellants respectfully request that these rejections be reversed for the reasons presented herein.

4. For a rejection under Section 103(a) to be proper it must comply with the statutory provisions and controlling case law. The text of Section 103(a) was stated in the Final Office Action. (*See*, Final Office Action, pg. 2.) The US Supreme Court outlined the four factual inquiries in considering and determining of obviousness under Section 103(a), in *Graham v. John Deere*, as follows:

- (A) Determining the scope and contents of the prior art;
- (B) Ascertaining the differences between the prior art and the claims in issue;
- (C) Resolving the level of ordinary skill in the pertinent art; and
- (D) Evaluating evidence of secondary considerations.

(*See*, 383 U.S. 1, 17-18 (1966).)

5. The MPEP informs that it is Office policy to following *Graham*. (*See*, MPEP § 2141.) In determining obviousness, the legal concept of *prima facie* obviousness is a well established procedural tool of examination to allocate the burden between the examiner and applicant. (*See*, *In re Fielder*, 471 F.2d 640, 642 (CCPA 1973).) Once *prima facie* obviousness is established by the examiner, the burden to rebut the position with objective evidence of no obviousness shifts to the applicant. (*See*, *Id.* at 642-43.) When a *prima facie* case of obviousness depends on two references there must be some teaching, suggestion or motivation to combine the references. (*See*, *In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir.

1998) (“To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show a motivation to combine the references that create the case of obviousness.”).) Substantial evidential support for the motivation to combine the references must be shown in the prior art. (*See, In re Lee*, 277 F.3d 1338, 1343-44 (Fed. Cir. 2002) (“This factual question of motivation is material to patentability, and could not be resolved on subjective belief and unknown authority.”); *see also, In re Kotzab*, 217 F.3d 1365, 1371 (Fed. Cir. 2000) (“[P]articular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed.”).) In the absence of a proper *prima facie* case of obviousness, the applicant is entitled to a patent. (*See, In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998).)

6. The Examiner has failed to carry this initial burden to establish a *prima facie* case of obviousness based on the existing factual record. In the Answer, the Examiner repeated the assertion from the Final Office Action that Yu ‘930 teaches all limitations of previously presented in independent claims 1 and 6 other than the feature of “at least one exterior wall is entirely vacated.” (*See*, Examiner’s Answer, pg. 3.) The Examiner continues by repeating that Yu ‘386 teaches “a computer chassis for an electronic device comprising a vacated exterior wall (20) which can be placed in the vacated portion to complete the full assembly of the chassis.” (*See*, Examiner’s Answer, pgs. 3-4.) However, the Answer did not repeat the Examiner’s previous attempt to clarify the use of teachings of Yu ‘386 by stating that “the examiner was using Yu ‘386 only to teach vacating an entire wall of a chassis as claimed.” (*See*, Final Office Action, pg. 7; emphasis in original; *see also*, Final Office Action, pg. 7, “examiner is merely using the Yu ‘386 references to teach ‘at least one exterior wall... [is] entirely vacated.’”).)

7. To support the motivation to combine these two references, the Answer repeats the assertions from the Final Office Action that it “would be obvious to one of ordinary skill in the art at the time of the invention was made to modify the interchangeable access panel of Yu ‘930 to include the entire rear panel as taught by Yu ‘386 to provide *better access* to the components of the computer system.” (See, Examiner’s Answer, pg. 4; emphasis added.) Relying on column 1, lines 40-42 of Yu ‘386, the Examiner states that “having a removable panel as taught by Yu ‘386 provides for *better access* to the components compared to the partial opening of Yu ‘930.” (See, Examiner’s Answer, pg. 4; emphasis added.)

8. The Examiner emphasizes that “the Yu ‘386 reference teaches the motivation listed by the examiner” by citing the following passage of Yu ‘386: “The present invention provides a computer case, which facilitates the replacement, update, and maintenance of computer equipment.” (See, Yu ‘386, col. 1, lns. 1-40.) In the Answer, the Examiner repeats the contention that a motivation to combine is found in the Yu ‘386 reference. Appellants respectively disagree that this motivation, alleged to have been found by the Examiner, is substantial evidence that one of ordinary skill in the art would be have been motivated to combined Yu ‘930 in view of Yu ‘386.

1. The Examiner failed to provide any substantial evidence to support a proper motivation to combine rejection.

9. The Examiner has failed to provide any substantial evidence for the assertion that one of ordinary skill, without having the benefit of Appellants’ novel teachings before them, would have been motivated to combine the teachings of the two references to support the rejection of independent claims 1 and 6 and, as such, has thus failed to establish a *prima facie* case of obviousness. The rejection of independent claims 1 and 6 are therefore improper and should be reversed.

10. In the Answer, the Examiner focuses only on whether any conceivable evidence has

been presented to support the motivation to combine, and completely ignores the evidence that is offered. Appellants acknowledge that the Examiner provided speculative evidence in an attempted to offered *some* evidence of a motivation to combine, but that this evidence is not substantial evidence. The only evidence for supporting the motivation to combined offered by the Examiner is the fact that Yu '386 provides "improved access" or "better access". As stated by the Federal Circuit in *In re Lee*, a factual inquiry cannot be resolved by a "subjective belief and unknown authority." (See, *In re Lee*, 277 F.3d at 1344.) Nor can the factual inquiry be resolved by simply alleging that Yu '386 provides a general advantage of "improved access" or "better access" in the subjective view of the Examiner, as has been done in the Final Office Action and Answer. Virtually all patents can be said to have some general advantage. A general advantage cannot be used as substantial evidence to support a motivation to combine selected elements from multiple references. Therefore, the Examiner's assertion that the improved access of the computer case of Yu '386 would motivate one to combine the teachings of Yu '930 is based on a subjective belief that fails to meet the substantial evidence requirement to support a *prima facie* obviousness rejection.

2. The type of access provided by Yu '386 and Yu '930 are not compatible such that an improvement by one would necessarily mean an improvement to the other.

11. In reviewing the evidence that the Examiner submitted to support a motivation to combine, it is clear the type of access referred to in Yu '386 is not the same access referred to Yu '930. Since the types of access are incompatible, the improved access, based on a subjective belief from the Examiner, from one would not translate to the other. This highlights the fundamental problem in using a general advantage as evidence to support a motivation to combine as the Examiner has done in the Final Office Action. Contrary to the characterization in the Answer, Appellants are not arguing that the test for obviousness is "whether the features of a secondary reference may be bodily incorporated into the structure

of the primary reference.” (See, Answer, page 7.) Instead, an analysis of the insubstantial evidence offered by the Examiner clearly shows the general nature and incompatibility of the evidence. Thus, such evidence is being improperly used to support a motivation to combine.

12. Yu ‘930 and Yu ‘386 address different problems and, as such, Yu ‘930 does not seek the same type of access that Yu ‘386 provides. Yu ‘930 teaches an interchangeable panel (50, 90) that is placed in a window (70) in the rear wall (22) as shown in FIG. 3. (See, Yu ‘930, col. 3, lns. 54-60.) The interchangeable panel (50, 90) is provided with several slots (76) for access to the accessory cards in the case (12). (See, Yu ‘930, col. 4, lns 7-20.) This access of Yu ‘930 allows a user to access the internal cards while the panel is attached in a window on the rear of the case. In contrast, Yu ‘386 provides access for replacement, update and maintenance of the components when the L-shaped front panel (22) is removed. (See, Yu ‘386, col. 2, lns 14-27; lns. 43-52.) The following chart illustrates the differences:

Patent	Yu ‘930	Yu ‘386
Location	Window in rear panel	Front panel that is L-shaped
Type of Access	Access when attached	Access when detached
Purpose of Access	Align with the accessories in case depending on type of motherboard	Replacement, maintenance and update of the components when front panel is removed

13. The Examiner has also mischaracterized Yu ‘386. In the Answer, the Examiner stated that “Yu ‘386 reference *clearly* suggests entirely vacating a wall of a computer chassis to provide, ‘a computer case which facilitates the replacement, update, and maintenance of computer equipment.” (See, Answer, page 8, citing Yu ‘386, col. 1, lns. 40-42; emphasis added.) The Examiner’s characterization of Yu ‘386 is wrong. Yu ‘386 does not teach that the entirely vacated wall facilitates the replacement, update, and maintenance of computer equipment. To the contrary, in Yu ‘386 it is the bottom-less inverted-L shape of the detachable front board that provides the access when removed. (See, Yu ‘386, col. 2, lns. 45-52.) According to Yu ‘386 this design is an improvement over the prior art that uses a

detachable front board having a base, as shown in FIG. 1. (*See*, Yu '386, col. 1, lns. 12-39.) While an entire wall is shown vacated in FIG. 3 of Yu '386, it is not the entirely vacated wall that provides the advantage sought by Yu '386. Therefore, a proper understanding of Yu '386 is that the bottom-less inverted L-shaped front panel provides the referenced advantage, not an entirely vacated wall.

14. Regardless of these differences the Examiner states that "it is desirable to modify Yu '930 with the teachings of Yu '386 since doing so will allow improved access to the internal components to, 'facilitate the replacement, update and maintenance of the computer equipment.'" (*See*, Answer, page 8.) Appellants respectively disagree with this statement. Again the improved access is based on a subjective belief of the Examiner, to which Appellants object as discussed above. The general advantage of improved access of Yu '386 would not motivate a person of ordinary skill in the art to combine the teachings of Yu '930 in view of Yu '386. The access desired by each cited patent is incompatible such that improved access by Yu '386 would not translate to improved access for Yu '930. For example, Yu '930 seeks to access the internal components when the panel is attached, while Yu '386 seeks to access the internal components when the panel is removed. An improvement of access in Yu '386 when the panel is removed does not improve the access of Yu '930 when the panel is attached. Also for example, Yu '930 seeks to access the internal components from the rear, while Yu '386 seeks to access the international components from the front. An improvement of front access in Yu '386 does not improve the rear access of Yu '930. The fact that Yu '386 provides improved access in the subjective belief of the Examiner does not mean that improved access would be shared or desired by Yu '930. Thus, the evidence relied upon by the Examiner to support the motivation to combination is not substantial evidence as evident by the differences in the types of access.

15. It is inappropriate for the Examiner to argue that Yu '386 provides better access to support a motivation to combine, when Yu '930 neither seeks nor suggests the type of access afforded by Yu '386. The Federal Circuit in *In Re Mills* held that there must be some desirability to make the modification, and the mere fact that the reference can be combined does not suggest a proper motivation to combine. (*See*, 916 F.2d 680, 682 (Fed. Cir. 1990).) Based on the Examiner's evidence of a motivation to combine, there is no desirability from Yu '930 or Yu '386, either alone or in combination, to make a combination due to the differences exemplified above. The modification of Yu '930 using Yu '386 by the Examiner in the Final Office Action is nothing more than arranging a collection of parts, none of which is desired by the prior art of record. The Examiner is simply finding a reference that shows what Yu '930 admittedly lacks, without deference to the desirability to make the combination.

B. The Examiner improperly rejected independent claims 1 and 6, and dependent claims 2-5, 7, and 9-15 as being unpatentable over Yu '930 in view of Yu '386 Based on Hindsight.

16. The Examiner's assertions of motivation to combine based on the Examiner's subjective belief of advantages in only the secondary reference is an improper use of hindsight. The Federal Circuit has repeatedly stated that the use of hindsight must be guarded against by having the Examiner provide substantial evidence to support the motivation. (*See, e.g., In re Rouffet*, 149 F.3d 1350 (Fed. Cir. 1998); *In re Dembiczak*, 175 F.3d 994 (Fed. Cir. 1999).) In this situation, the Examiner is using a general advantage seized only from a subjective belief about the secondary reference, Yu '930, to teach a missing element of the primary reference, Yu '386, to support a *prima facie* case of obviousness. There is no objective, substantial evidence on the record of this application that shows a motivation to combine Yu '930 in view of Yu '386. Instead, the Examiner claims to find all the elements of Appellants' claimed invention in the two applied references and improperly combines the

references without relying on objective evidence. Absent objective evidence, and based on Federal Circuit precedent, it can be reasonably assumed that the Examiner selected the references with the assistance of hindsight. (*See, In re Rouffet*, 149 F.3d 1350, 1358 (Fed. Cir. 1998).) This selection using hindsight is further shown by the lack of a motivation in Yu '930 to use anything other than a panel that fits within a window on a rear wall. In asserting that the prior art "suggested" the claimed subject matter, an Examiner may not "use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious." (*See, In re Fritch*, 972 F.2d 1260, 1266 (Fed. Cir. 1992).) The Federal Circuit has further stated that "[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." (*See, Id.*) Here, in an attempt to construct a *prima facie* obviousness rejection, the Examiner has selected features from different references, but has not provided substantial objective evidence showing that one of ordinary skill at the time of invention would have combined the same selected elements in the same manner as the Examiner proposes. This is impermissible hindsight reconstruction used to reject independent claim 1.

17. Thus, the only conclusion that can be drawn, based on the record of this application, is that the suggestion forming the basis for the Examiner's otherwise factually unsupported conclusion must have come from Appellants' own novel disclosure; that is, they are based on impermissible hindsight. This failure of the Examiner's reasoning in attempting to make out a *prima facie* obviousness case is sufficient reason alone to reverse the Section 103 rejection of independent claims 1 and 6, and dependent claims 2-5, 7, and 9-15.

18. In response these arguments, the Examiner attempts to justify the use of hindsight in the Answer by noting "that one of ordinary skill in that art would acknowledge that removing

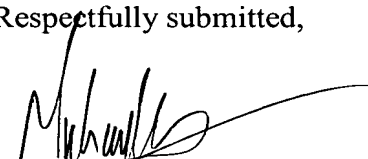
an entire panel of a chassis will provide better access to the internal workings thereof.” (*See*, Answer, page 9.) This statement is wholly irrelevant to the claims on appeal. None of the claims have a feature of removing an entire panel of a chassis to provide better access to the internal workings thereof. Therefore, this statement does nothing to negate that fact that the Examiner used hindsight when rejecting the claims.

II. CONCLUSIONS

19. For the reasons noted above as well as the reasons provided in the Appeal Brief filed on September 15, 2006, Appellants submit that the pending claims define patentable subject matter. Accordingly, Appellants request that the Examiner’s rejection of these claims be reversed and that the pending application be passed to issue.

Respectfully submitted,

Dated: January 9, 2007



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